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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,802	04/18/2001	Hans Ruckert	21753	5223

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EXAMINER

HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,802

Applicant(s)

RUCKERT ET AL.

Examiner

Isaac N Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
3. The disclosure is objected to because of the following informalities: page 6, line 6 "particular suitable" should be --particularly suitable--. Appropriate correction is required.

Claim Objections

4. Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 16 is not consistent with independent claim 8 with respect to their preambles, if intended to be dependent on claim 8.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, because it states a limitation which is contradictory to what is disclosed in the specification on page 5, lines 24-26.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 15 are rejected because they are vague and indefinite. They do not indicate to which claims they depend on. Claim 13 recites that it is dependent upon itself, and claim 15 recites the same.

Regarding claim 16, line 2, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 16 is rejected because it is an independent claim with dependency on another claim. In line 5, there is a dependency on claim 8.

Claim 16 is still further rejected because it recites, "a cutting edge of the blades is coated as defined in claim 8." However, this statement indicates that claim 8 is a method claim, which it is not. Claim 8 is an article claim.

Claim Rejections - 35 USC § 102

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by DeTorre (5,423,240).

Regarding claim 8, note steel cutting edge 35 and column 1, line 25; coated edge 36 and note depth of 0.00197 inches to 0.01972 inches in column 2, lines 59-60. Note the range in Claim 8 corresponds to 0.00197-0.01972 inches. Note cutting paper in column 4, lines 41-50.

Regarding claim 9, note depth of 0.00197 inches to 0.01972 inches in column 2, lines 59-60. Note the range in Claim 9 corresponds to 0.00394-0.007874 inches.

Regarding claim 10, note Rockwell Hardness 60-67 in column 2, line 34; note Rockwell Hardness 69-78 in column 3, line 61. Note the range in claim 10 corresponds to Rockwell Hardness 64-74.

Regarding claim 11, note Rockwell Hardness 60-67 in column 2, line 34; note Rockwell Hardness 69-78 in column 3, line 61. Note the range in claim 11 corresponds to Rockwell Hardness 67-72.

Regarding claim 12 and 13, note tool steel in column 2, lines 30-32.

Regarding claim 14, note tungsten in column 3, line 60.

11. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Faltin (4,854,204). Note the first paragraph in the abstract that recites a moving material web of paper, and a pair of circular blades used in a system. It is assumed claim 16 is intended to be independent.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeTorre in view of Kai et al. (4,977,807), hereafter Kai. DeTorre discloses everything as noted above but does not disclose a blade with a portion of molybdenum or tungsten ions that is smaller than the portion of titanium ions. However, Kai teaches a blade with a portion of molybdenum or tungsten ions that is smaller than the portion of titanium ions. It would have been obvious to provide DeTorre a blade with a portion of molybdenum or tungsten ions that is smaller than the portion of titanium ions in order to provide a sharp cutting edge for a long time. It is noted that the portion of molybdenum or tungsten ions in Kai is zero. Note column 9, lines 43-50 in Kai.

Election/Restrictions

14. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 8-15, drawn to a blade for cutting a moving material web, classified in class 83, subclass 676.
- II. Claim 16, drawn to an apparatus for longitudinally cutting a moving material web, classified in class 83, subclass 614.

The inventions are distinct, each from the other because:

15. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require

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the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the cutting edge in claim 16, line 4 can be made of aluminum, instead of steel as claimed in claim 1, line 2. The subcombination has separate utility such as being used in a hand tool configuration. The blade in claims 8-15 can be attached to a handle and used to cut materials such as cheese or latex, instead of paper, cardboard, plastic or metal foil.

16. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hunt, Pfeiffer and Masters et al. are cited for blades with similar properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 703-305-4949. The examiner can normally be reached on Monday thru Friday between 8am and 5pm. If attempts to

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reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

JA

IH

August 20, 2002



Allan N. Shoap
Supervisory Patent Examiner
Group 3700